



PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 059643.00294
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/625,909
	Filed: July 24, 2003
	First Named Inventor: Marco STURA
	Art Unit: 2617
	Examiner: Justin Ye Lee

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 60,180

☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____

Signature

Michael A. Leonard II

Typed or printed name

703-720-7883

Telephone number

September 12, 2008

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Marco STURA et al.

Art Unit: 2617

Application No.: 10/625,909

Examiner: Justin Ye Lee

Filed: July 24, 2003

Attorney Dkt. No.: 059643.00294

For: CHARGING IN COMMUNICATION NETWORKS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 12, 2008

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005, Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1, 2, 4-6, 8-21, 23 and 33-49 in the above-identified application. Claims 1, 2, 4-6, 8-21, 23 and 33-49 were finally rejected in the Office Action dated May 12, 2008. Applicants filed a Response to the outstanding final Office Action on June 27, 2008, and the Office issued an Advisory Action dated August 4, 2008, maintaining the final rejections of claims 1, 2, 4-6, 8-21, 23 and 33-49. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Gemmer is Clearly not Prior Art with Respect to the Present Application

In the outstanding final Office Action, the Examiner rejected all of the pending claims as being obvious, in part, over Gemmer. Applicants respectfully submit that Gemmer is clearly not prior art with respect to the present application and that the rejections over Gemmer constitute clear error in the Office Action.

The Office Action rejected claims 1, 20, 21, 23, 33, 41 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Gemmer (U.S. Publication No. 2004/0022233) in view of Lundstrom (U.S. Publication No. 2002/0191597) and further in view of Moon (U.S. Publication No. 2002/0102970). The Office Action also rejected claims 2, 4-6, 8-19, 34-40 and 42-48 under 35 U.S.C. § 103(a) as being unpatentable over Gemmer in view of Lundstrom and Moon, and further in view of Applicants' Background. On page 14 of the previous Response, Applicants argued that "Gemmer is not prior art because the PCT application of Gemmer was not published in English. Thus, Gemmer does not qualify under 35 U.S.C. 102 and 35 U.S.C. 103. Therefore, this rejection is rendered moot."

In response to Applicants' arguments, the Advisory Action stated on page 2 that "[i]n contrast to the Applicant's assertions, the Applicant never brings up an argument against the validity of Gemmer's filing/publishing date in any previous office actions, therefore, admitted Gemmer is a valid prior art [sic]." However, Applicants made no admission that Gemmer is prior art with respect to the present application at any point during prosecution. Also, Applicants are under no duty to identify every error in each rejection at the earliest time during prosecution. Applicants note that patent prosecution is an *ex parte* process that is not intended to be adversarial, and Applicants do not forfeit the right to present certain arguments if they are not presented at a certain time, unlike litigation. Further, Applicants are not aware of any duty created under U.S. law or regulation, or USPTO rule, that mandates otherwise.

The Advisory Action also asserted on page 2 that "[i]n addition, Gemmer's national stage application (application number 10/399,322 was filed on 4/17/2003), therefore Gemmer reference is a prior art [sic]." However, Applicants note that Gemmer clearly fails to qualify as prior art under 35 U.S.C. § 102(e). For the Board's convenience, Applicants refer to the attached 35 U.S.C. § 102(e) flowchart from MPEP § 706.02(f)(1). As can be seen, the first inquiry is whether "the reference [is] a U.S. patent or U.S. application publication of an International Application (IA) after National Stage entry". As is clear from the first page of Gemmer, this is the case since Gemmer relies on PCT application no. PCT/DE01/03975. The next inquiry is "[w]as the IA filed on or after Nov. 29, 2000?" As can also be seen from the first page of Gemmer, the PCT application was filed on October 18, 2001, which is **after** the date of November 29, 2000. The final inquiry in this case is "[w]as the WIPO publication of the IA in English **and** did the IA designate the U.S.?" (emphasis added). The PCT application for Gemmer was filed in German (see corresponding PCT application at the WIPO website - <http://www.wipo.int/pctdb/en/>). As such, the flowchart clearly indicates that Gemmer has **no 35 U.S.C. § 102(e) date**. Further, since the priority date for the present application is May 13, 2003, and Gemmer was not published until February 5, 2004, Gemmer also clearly fails to qualify as prior art under 35 U.S.C. §§ 102(a) or (b).

Thus, Gemmer is not prior art with respect to the present application under any section of 35 U.S.C. § 102. As such, the rejections over Gemmer constitute clear error in the Office Action.

While the above reasons regarding Gemmer not being prior art with respect to the present application are more than sufficient to demonstrate clear error in the Office Action and require that the rejections be withdrawn, the following arguments are presented regarding further errors in the Office Action.

In the outstanding final Office Action, the Examiner also rejected the claims over Lundstrom and Moon. Applicants respectfully submit that Lundstrom and Moon clearly fail to teach or suggest the features alleged in the Office Action, and that this failure constitutes clear error in the Office Action.

Independent claim 1 recites, in part, "resuming said session with a message indicating active session from said user equipment by which said charging identifier for the first access network is forwarded from said first node of the second network to a second node of the second network, wherein the first access network is different from the second network." Independent claims 21, 23, 33, 41 and 49, which each have their own scope, recite similar features. Applicants respectfully submit that Lundstrom and Moon, both individually and in combination, fail to teach or suggest these features.

In the previous Response, Applicants respectfully submitted on page 14 that there is no teaching or suggestion in the cited art of configuring, for example, a P-CSCF node such that it forwards a charging identifier to, for example, a S-CSCF node in response to receiving an active session message sent by user equipment. Paragraph [0045] of Lundstrom generally discusses forwarding a GPRS charging identifier from a P-CSCF node to a S-CSCF node, but Lundstrom is completely silent as to how or when this is done. The Advisory Action stated on page 2 that “[i]n contrast to Applicant’s assertions, Lundstrom teaches the forwarding of a charging identity is sent from a GGSN6 to a P-CSCF9 then to a S-CSCF10 during a setting up of a connection (paragraph 45 and Fig. 2).” However, Applicants respectfully submit that this is not the case.

Paragraph [0045] and Fig. 2 of Lundstrom discusses that a charging identifier may be sent from a P-CSCF to a C-CSCF during the setup of a connection and at the initiation of the GGSN (with respect to the latter, Applicants note that Fig. 2 appears to illustrate sending a “GPRS call identity/GGSN node identity” from the P-CSCF to the S-CSCF as part of the succession of arrows **beginning at the GGSN**). Even if Moon teaches resuming a session with a message indicating an active session, which is not admitted, it is not understood how Lundstrom is considered to render obvious forwarding a GPRS charging identifier with such an active session message. This is because:

- (a) Lundstrom is understood to generally discuss initiating of sending of a GPRS charging identifier **at the GGSN** (i.e., in a message beginning at the GGSN); and
- (b) Lundstrom is understood to indicate that there is no need to send a GPRS charging identifier after a session is put on hold, and then resumed, because Lundstrom is understood to discuss communicating a GPRS charging identifier to a S-CSCF **during initial session setup**.

Accordingly, it does not follow that it would have been obvious to have configured the system of Lundstrom such that forwarding of a charging identifier from the P-CSCF to the S-CSCF mentioned in Lundstrom is done together with forwarding of a message indicating an active session from user equipment. Paragraph [0013] of the present application describes how it was conventional practice to forward the charging identifier from a P-CSCF to a S-CSCF in a SIP UPDATE message.

Applicants reiterate that the Office Action has not indicated how Moon, or any of the other cited art, allegedly provides a reason, let alone a motivation, for a person skilled in the art to deviate from this conventional practice and instead configure the system of Lundstrom for forwarding charging information to the S-CSCF with a message indicating an active session. The Advisory Action merely stated on page 2 that “Moon teaches a setting up of a connection is initiated from an user equipment [sic] (paragraph 21-30).” However, no motivation or reasoning for this combination is provided.


Per the above, the combination of Lundstrom and Moon clearly fails to teach or suggest the features alleged in the Office Action and Advisory Action. Accordingly, Applicants respectfully submit that the rejection of the claims over the cited art constitutes clear error in the Office Action.

Conclusion

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, Applicants

respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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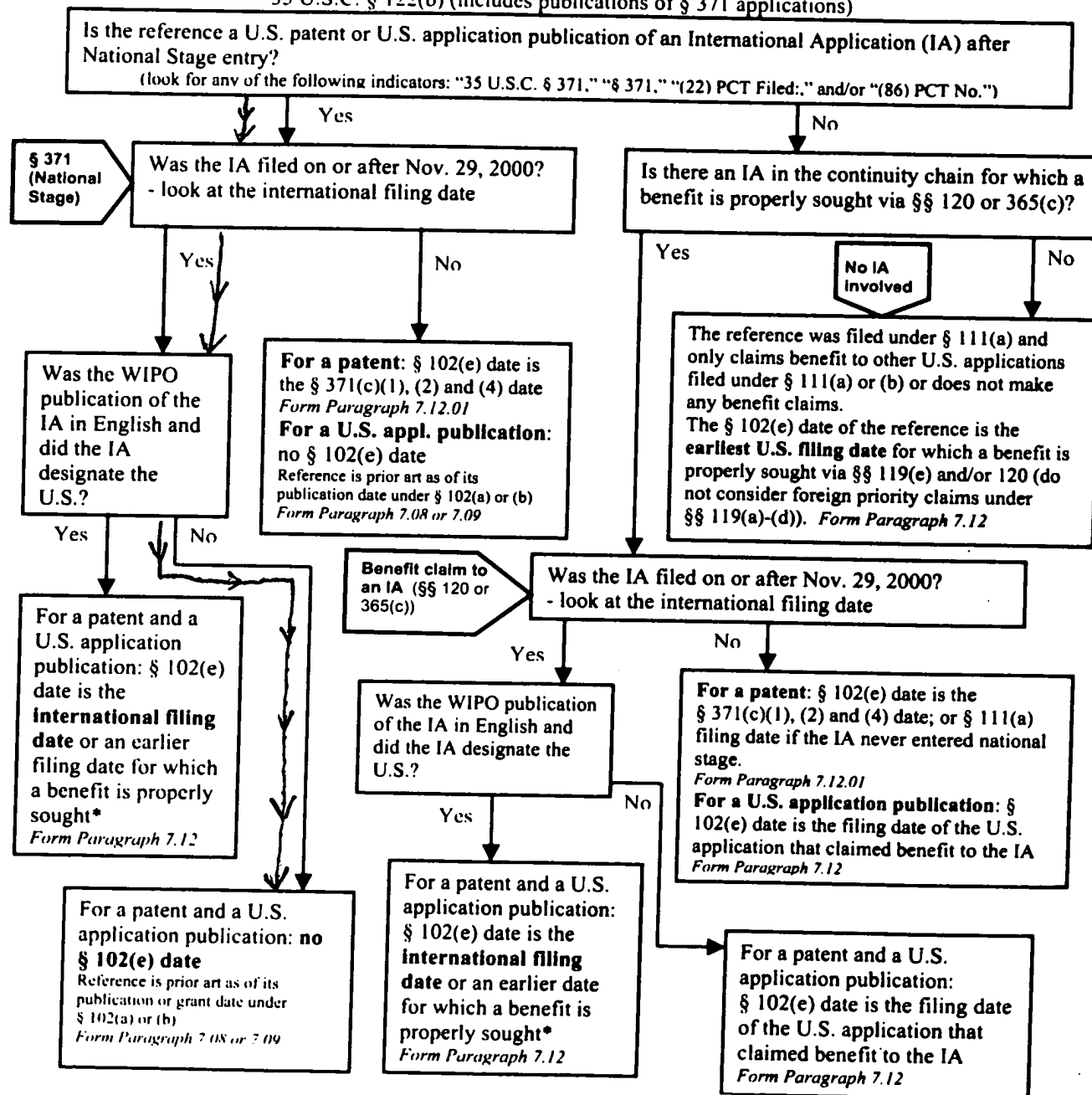
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Enclosures: PTO/SB/33 Form
Notice of Appeal
Petition for Extension of Time
102(e) Flowchart
Check No. 19626

III. FLOWCHARTS

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FLOWCHARTS FOR 35 U.S.C. § 102(e) DATES:**Apply to all applications and patents, whenever filed****Chart I: For U.S. patent or U.S. patent application publication under 35 U.S.C. § 122(b) (includes publications of § 371 applications)**

* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.